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IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

RICHARD D. GREEN,
Petitioner,

vs.

GERBER PRODUCTS COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

MARK P. WINE
Counsel of Record

CHARLES ROSENBERG
GUY PORTER SMITH

OPPENHEIMER POMS SMITH

2029 Century Park East, Suite 3800
Los Angeles, California 90067
(310) 788-5000

Attorneys for Petitioner

Lawyers Brief Service • Appellate Brief Printers • (213) 613-1013 • (714) 720-1510

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QUESTIONS PRESENTED

1. Whether the Federal Circuit's "point of novelty" test used in determining design patent infringement conflicts with this Court's prior opinions and the litigant's Seventh Amendment right to a jury trial.

2. Whether the Federal Circuit's affirmance of the district court's summary judgment of design patent non-infringement allowing the district court judge to combine unrelated references and resolve disputed issues of fact is a failure to comply with precedent that requires an ornamental suggestion before combining unrelated, prior art references.

LIST OF PARTIES TO THE PROCEEDING

The names of all parties in the Court whose judgment is sought to be reviewed appear in the caption of this Petition for a Writ of *Certiorari*.

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PETITION FOR WRIT OF CERTIORARI

Petitioner, Richard D. Green, respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The unpublished opinion of the Federal Circuit is reprinted herein as Appendix A. The Order denying the petition for rehearing and the suggestion for rehearing en banc is reprinted herein as Appendix D. The district court's order entered with regard to the cross motions for summary judgment is reprinted herein as Appendix B. The report's transcript of proceedings for the cross motions for summary judgment is reprinted herein as Appendix C.

JURISDICTION

The Federal Circuit entered its order denying a combined petition for rehearing and suggestion for rehearing en banc on October 6, 1997. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISIONS INVOLVED

The Seventh Amendment of the United States Constitution provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in

any Court of the United States, than according to the rules of the common law.

FEDERAL STATUTES INVOLVED

This case involves the following statutory provisions:

35 U.S.C. § 171 Patents for designs

• • •

The provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided.

35 U.S.C. § 289 Additional remedy for infringement of design patent.

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any *colorable imitation* thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or *colorable imitation* has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties (emphasis added).

STATEMENT OF THE CASE

This case presents the question whether the Seventh Amendment permits courts in jury design patent infringement actions for damages to resolve as a matter of law disputed factual issues in conducting an infringement

analysis. The Federal Circuit approved the district court's analysis of non-infringement that necessarily depended on combining unrelated prior art design references, determining the point of novelty of a patented design, and finding that the accused product design is not a colorable imitation of the patented design by its express holding of non-infringement.

I.

THE PATENT

Petitioner Richard D. Green owns United States Patent No. Des. 349,769 titled "Protective Cap for a Baby Bottle." (App. E). This patent is for an ornamental design of a protective cap for a baby bottle. *Id.*

II.

THE ACCUSED DESIGN

Respondent Gerber Products Co. manufactures and sells a variety of baby bottles that incorporate the protective cap which is a colorable imitation or infringement of the patented design. (App. F1).

III.

DISTRICT COURT LITIGATION

Green sued Gerber for patent infringement under 35 U.S.C. § 271 and sought damages as provided under 35 U.S.C. § § 284 and 289. Before the discovery cut-off date the parties filed cross motions for summary judgment. Green filed a partial summary motion for patent

infringement. Gerber responded with its partial summary judgment motion for non-infringement and invalidity.

Green's motion introduced evidence that Gerber's protective caps are virtually identical to the protective caps illustrated by his patent. Gerber's opposition argued that an ornamental design patent cannot cover (1) the structural or functional aspects of the accused article, and (2) the ornamental aspects of the accused article are shown in the prior art. In making this argument Gerber relied on the patents to Brown (App. G), Campbell (App. H), and Zimmermann (App. I).[1]

Gerber's cross motion for invalidity contended that the Green patent was invalid (1) for obviousness over the Campbell and Zimmermann patents (App. H and I), and (2) for functionality. In opposing the invalidity aspect of the motion, Green argued that there was no teaching, suggestion, or incentive supports the ornamental modification of the Campbell patent (App. H) by the Zimmermann patent (App. I) except through the use of impermissible hindsight incentive that resulted from Gerber's copying of the Green design. Gerber did not dispute that its executives discussed Green's novel design with Green at least twice. One discussion occurred at the Juvenile Products Manufacturers Association Show in October 1992. Gerber management showed its further interest in Green's novel design at a second meeting at Chicago's O'Hare Airport on January 18, 1993.

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[1] Gerber's translation of the issued French patent to Kurt Zimmermann is provided. The original issued French patent has been omitted.

Green further demonstrated the validity of his design based upon the objective evidence of non-obviousness which included evidence that Gerber had captured a 24% market share for its protective cap and baby bottle. Green opposed the functionality aspect of Gerber's invalidity argument by demonstrating that one could accomplish the functional purpose of the design in many other ways.

Gerber's partial summary judgment motion for non-infringement relied on the same arguments that it used in opposing Green's partial summary judgment motion for infringement.

Green also filed a declaration under F.R. Civ. P. 56(f) requesting that the court deny or continue Gerber's partial summary judgment motion so that essential discovery could be completed that would have demonstrated that Gerber had copied Green's ornamental design for its protective cap.[2] (App. C13). Green needed the continuance because Gerber filed its motion only after obtaining a continuance to respond to Green's discovery. The district court denied the requested continuance.

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[2] Green believed that a compelling justification for the continuance existed. The complaint was filed on December 4, 1995. Green served his first set of discovery documents on February 27, 1996. On March 6, 1996, the district court established a discovery cut-off date of August 30, 1996. Green had anticipated receiving full and complete discovery responses from Gerber on April 1, 1996. On March 29, 1996, Green agreed to Gerber's request for a discovery response continuance until April 16, 1997.

During the summary judgment hearing, the district court first announced its tentative conclusion that it would hold the Green patent valid as narrowly interpreted and hold that Gerber's protective cap does not infringe the Green patent. (App. C3-4). The district court reasoned that the question of patent validity is one of law and thus appropriate for resolution upon summary judgment. (App. C4). In response to Gerber's challenge that the Green patent was invalid for being dictated by function, the court held that there were alternative methods of sealing baby bottle nipples. As a result, the court concluded that the particular nipple seal design is not functional. (App. C4).

In addressing the obviousness issue, the district court concluded that the patent had to be narrowly construed because a broad interpretation would lead to the finding of invalidity (App. C4). It reasoned that the elements of a sloped bottle cap and the particular nipple seal design in the Green patent had been disclosed in the prior art, ranging from the French patent (to Zimmermann), the Campbell patent, and a prior Gerber patent (to Brown). (App. G-I). Without identifying a primary and secondary reference in the court's analysis, the court reasoned that the disclosed elements from the prior art patents caused the patented design to be obvious to a designer of ordinary skill. However, the court further reasoned that it would not interpret the Green patent to be invalid if it could avoid that holding because of the presumption of patent validity. (App. C5).

The district court concluded that no material issues were in dispute concerning infringement and validity. (App. C5). It entered judgment for Gerber on the issue of

non-infringement and for Green on the issue of validity. (App. B and C).

IV.

FEDERAL CIRCUIT OPINIONS

Green appealed the district court's finding of non-infringement. Gerber appealed from the district court's validity holding. On August 12, 1997, the Federal Circuit affirmed the district court's determination of non-infringement and vacated the judgment of patent validity. (App. A1).

Green filed a petition for a rehearing and a suggestion for rehearing en banc. He asserted four probative points:

1) The decision by the Federal Circuit departed from prior case authority by permitting the combination of prior art references (a) in the absence of any primary reference and (b) without any demonstration that the combinations were suggested or taught by the secondary references.

2) The decision by the Federal Circuit approved the use of utility patent concepts and references as a basis for narrowing the scope of Green's design patent despite clear authority that prohibits such use.

3) The decision by the Federal Circuit approved the practice of allowing a trial court a free hand to deny enforceability of a design patent without either (a) considering the degree of overall visual similarity between the design patent and the claimed infringement or (b) determining and announcing on the record what the specific

points of novelty were for purposes of the infringement analysis.

4) By reasons of the errors committed by the district court, it was improper for the Federal Circuit to affirm the decision without opinion.

The Federal Circuit denied the petition for rehearing and the suggestion for rehearing en banc without comment on October 6, 1997. (App. D1).

REASONS FOR GRANTING THE WRIT

This Court should grant *certiorari* to decide whether in a design patent infringement action, where a jury is timely demanded, the Seventh Amendment permits judges to resolve, as a matter of law, all genuine disputes about the interpretation of a design patent claim, the scope of the patent claim, and the application of the patent claim in deciding that there is no infringement. In affirming the district court's finding of no infringement, the Federal Circuit ignored the precedent of this Court, its own binding precedent and more importantly, the right to a jury trial provided by the Seventh Amendment.

This case is of significant importance. If this decision is allowed to stand, the Federal Circuit's affirmance effectively eliminates Congress' intent to provide design patent holders protection from infringement. Under this ruling, a judge can combine prior art teachings from several references, without any teaching or suggestion for the combination. Then the judge can use the combined teachings to narrow the scope of the claim so much that the accused design avoids infringement. This development

will allow unscrupulous copiers of patented designs to avoid accountability for their actions by making trivial modifications to their product designs.

Design patent protection provides businesses with the opportunity to protect their investments in ornamental product designs.[3] The Federal Circuit's ruling drastically reduces design patent protection. Design patent owners will be unable to halt infringers. The constitutional right to a jury trial will no longer be available to protect a patent holder for a novel ornamental design from an infringer, even a copier.

I.

THE FEDERAL CIRCUIT'S DECISION IS INCONSISTENT WITH PRECEDENT OF THIS COURT

It has been more than 125 years since this Court has considered the test for design patent infringement. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871). This Court held:

> We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such

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[3] In fiscal year 1996, the Patent and Trademark Office ("PTO") issued 11,346 design patents. During the period 1990-95, the PTO issued 58,920 design patents. Annual Report for PTO for Fiscal Year 1996, <http://www.uspto.gov>.

> as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Gorham Mfg., 81 U.S. at 528. In establishing this test for infringement, this Court reversed the district court's holding that the test of infringement was that there be "substantial identity," "in view of the observation of a person versed in designs in the particular trade in question -- of a person engaged in the manufacture or sale of articles containing such designs -- of a person accustomed to compare such designs with one another, and who sees and examines the articles containing them side by side." *Gorham*, 81 U.S. at 527. This Court held that "[s]uch a test would destroy all the protection which the act of Congress intended to give."[4] *Id.*

In so holding, this Court stated that "there never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so that an expert could not distinguish them." *Id.*

Despite the clear direction provided by this Court, design patent infringement law in the post-*Gorham* era evolved to impose an additional test which defeats the scope of protection granted to design patent holders. This additional test requires that the accused device must appropriate the novelty in the patented device which

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[4] Congress provided that design patents are treated as all other patents under the Patent Laws except as where otherwise provided. See, 35 U.S.C. § 171 ¶ 2. Congress provided neither a new standard for infringement nor a point of novelty standard.

distinguishes it from the prior art.[5] *Payless Shoesource, Inc. v. Reebok Intern. Ltd.*, 998 F.2d 985, 990 (Fed. Cir. 1993). While the test seems harmless, its application requires that the point of novelty be identically present in the accused design. No variations for the colorable imitations of the novel design features are tolerated.

The judicially developed point of novelty test, which is unrelated to the interpretation of a design patent claim, requires a painstaking detailed analysis of the asserted patent in conjunction with the prior art in order to identify

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[5] The point of novelty requirement for infringement has not been uniformly accepted by the circuits. Prior to the formation of the Federal Circuit, the Sixth and Tenth Circuits applied the *Gorham* infringement standard. *Burger Train Systems, Inc. v. Ballard*, 552 F.2d 1377, 1381 (10th Cir. 1977); *Schnadig Corp. v. Gaines Mfg. Co.*, 494 F.2d 383, 391 (6th Cir. 1974). The Federal Circuit in *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) adopted the point of novelty requirement mentioned in *Sears Roebuck & Co. v. Talge*, 140 F.2d 395, 396 (8th Cir. 1944).

This split in authority is further demonstrated by the Federal Circuit which has repeatedly held that it will accept the decisions of the Court of Claims as binding precedent. *Pennwalt Corp. v. Durand-Wayland Inc.*, 833 F.2d 931, 951 (Fed. Cir. 1987); *South Corp. v. U.S.*, 690 F.2d 1368, 1370-71 (Fed. Cir. 1982). Despite this holding, the Federal Circuit in *Litton* ignored the holding in *Blumcraft of Pittsburgh v. U.S.*, 372 F.2d 1014, 1016 (Ct. Cl. 1967), which adopted the *Gorham* design patent infringement test.

the so-called point of novelty which must then be compared to the accused design. This test destroys the protection that Congress intended to give design patent holders under 35 U.S.C. § 289.

In conducting the point of novelty analysis, the district court performed a detailed side-by-side comparison of the Green design patent (App. E) with Gerber's protective cap. (App. F). The district court's comparison returned it to the standard that this Court rejected in 1872. The correct test is whether the invention or any colorable imitation thereof is applied to the accused design. See, 35 U.S.C. § 289.

II.

THE DECISION OF THE COURT OF APPEALS IS INCONSISTENT WITH PRECEDENT

The Federal Circuit ignored binding precedent by permitting a hindsight reconstruction of unrelated prior art references to narrow the scope of the design patent claim.

The Federal Circuit in affirming the district court allowed certain features identified in the prior art relied upon by Gerber to be improperly combined. The effect of the combination was exacerbated by the district court's vague interpretation that the Green patent must be narrowed to "particular angles and slopes" which were not found by the district court in the Gerber product. It has long been law of the Federal Circuit that the test for determining a proper combination of design patent references is "whether they are so related that the appearance of certain ornamental features in one would suggest the application of those

features to the other." *In re Glavis*, 230 F.2d 447, 450 (CCPA 1956). Moreover, as was stated in *In re Jennings*, 182 F.2d 207, 208 (CCPA 1950):

> In considering the patentability of a proposed design the appearance of the design must be viewed as a whole, as shown in the drawing, or drawings, and compared with something in existence -- not with something that might be brought into existence by selecting individual features from prior art and combining them...

More recently, the Court of Customs and Patent Appeals in *In re Rosen*, 673 F.2d 388 (CCPA 1982) expanded on the holding in *Jennings* stating that in order to constitute a reference from the prior art that bars patentability "there must be a reference, a something in existence, the design characteristics of which are basically the same as the claim design in order to support a holding of obviousness. *Rosen*, 673 F.2d at 391. *See also In re Harvey*, 12 F.3d 1061, 1063 (Fed. Cir. 1993). Finally, "A finding of obviousness cannot be based on selecting features from the prior art and assembling them to form an article similar in appearance to the claimed design." *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996). *See also Durling v. Spectrum Furniture Co.*, 100 F.3d 101, 103 (Fed. Cir. 1996) (cannot combine prior art designs without first finding a single reference that contains some overall visual appearance and design characteristics of claim design).

The district court failed to follow this clear precedent. Instead, it followed a course of "picking and choosing" among features pointed out to it by Gerber in the prior art. In

order to create out of thin air a "something" that did not actually exist prior to the Green patent. As the prior art patents to Brown, Campbell, and Zimmermann show, no prior reference relied upon by the district court combines the truncated conical shape with the nipple seal. (App. G-I). Absent such a single reference, precedent flatly prohibits combining prior art design elements. Thus, by affirming the flawed district court opinion, the Federal Circuit departed from the precedent that it is bound to follow when interpreting and applying design patents. *See, South Corp.*, 690 F.2d at 1370-71.

III.

THE SEVENTH AMENDMENT RIGHT TO A JURY TRIAL REQUIRED THE ISSUE OF INFRINGEMENT TO BE PRESENTED TO A JURY

This Court has recognized that the question of novelty is to be submitted to the jury. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 1392 (1996). Notwithstanding this requirement, the Federal Circuit affirmed the district court's determination of non-infringement based upon district court's fact finding that the point of novelty is based upon the combining of several prior art patents. Neither Green nor Gerber identified the point of novelty as the "particular angles and slopes." Instead the district court, acting as a fact finder, wrongly made its own finding of novelty. The district court should not have decided the issue as a fact finder. It is well established that "at the summary judgment stage the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether

there is a genuine issue for trial." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249, 106 S. Ct. 2505, 2511 (1986).

The Federal Circuit's affirmance of that there was an absence of a material issue of fact and the district court's impermissible fact finding destroyed Green's right to secure a jury trial for an issue which belongs to the jury. The Federal Circuit's affirmance represents a dramatic turning point in denying a constitutional right to a jury trial that Green deserved.

CONCLUSION

The granting of this petition will restore the patent enforcement rights for design patent holders to what Congress intended by rejecting once again the infringement standard that this Court rejected in 1872.

For the reasons set forth herein, Green respectfully requests that the Court issue a Writ of *Certiorari* to review the judgment of the Court of Appeals for the Federal Circuit.

Dated: December 30, 1997

Respectfully submitted,

MARK P. WINE
Counsel of Record
CHARLES ROSENBERG
GUY PORTER SMITH
OPPENHEIMER ROMS SMITH

Counsel for Petitioner